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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,869	08/30/2001	Pascal Arnaud	212527US0	7528
22850	7590	08/16/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/941,869

Applicant(s)

ARNAUD, PASCAL

Examiner

Gina C. Yu

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 28 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.


NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-52 and 62-97.Claim(s) withdrawn from consideration: 53-57, 60 and 61.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

SHENGJUN WANG  
PRIMARY EXAMINER  


Continuation of No. 2:

The proposed amendment is not entered because the amendment would not place the application in allowable condition. The rejection would be maintained for the reasons of record.

Continuation of No.5:

Applicants assert that § 112 rejection should be withdrawn and assert that the “amount insufficient to cause at least one condition selected from the group consisting of a matte appearance, the sensation of dryness, the sensation of tautness and the sensation of discomfort on the keratin material after application of said composition to the keratin material” can be determined by one of ordinary skill in the art by routine experimentation. The present rejection is based on the second paragraph of 35 U.S.C. 112, which requires that the claims particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Examiner views that applicants fail to particularly point out and distinctly claim the amount of the volatile oil that applicants claim to use in the invention. There is no disclosure in the specification or prior art as to what this amount is, and it is difficult to determine the scope of the instant claims.

Applicants assertion that the amount can be determined by experimentation is not persuasive because there is no guidance in the specification as how one of ordinary skill in the art would go about to determine this amount. Rather, the argument would on the other hand raise the issue of whether such experimentation would be undue.

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Applicants' assertion that Fogel (US 6126951) does not compensate the deficiency of Jack et al. (US 5690918) is unpersuasive. Applicants ignore the teaching in Fogel that cyclomethicones or cyclic silicones, which are volatile oils used in Jack, have been under scrutiny for safety concerns and "untoward" effects, which would provide ample motivation to one of ordinary skill in the art to reduce the amount of the volatile oil to the claimed amount.

Regarding the rejection made over Mellul et al. (US 5738841), Fogel, and JP631412 abstract, applicants assert that Mellul fails to teach the claimed amount of inert particulate phase and does not related to transfer-resistant composition. Examiner reiterates that Examples 5 and 6 of the reference show compositions comprising 12 % of pigments, which are considered to meet the claimed inert particulate phase. Examiner also views that whether Mellul is specifically directed to transfer-free lipstick, the cited references are in analogous art because they are all directed to cosmetic and particularly lipstick compositions.

Regarding the double patenting rejection, applicants assert that the claimed invention in U.S. Pat. No. 6,326,012 requires additional elements not recited in the present claims. Examiner respectfully points out that the recited elements in the present claims are not exclusive. The rejection is proper as there is overlap in the scope of the both inventions.

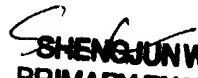
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner

  
**SHENGJUN WANG**  
**PRIMARY EXAMINER**